



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/496,893

02/02/2000

Stephen J. Brown

7553.00030 / 00-0220

6810

60683 7590 02/18/2010  
HEALTH HERO NETWORK, INC.  
2400 GENG ROAD, SUITE 200  
PALO ALTO, CA 94303

EXAMINER

SMITH, CAROLYN L

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

02/18/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/496,893	<b>Applicant(s)</b> BROWN, STEPHEN J.	
	<b>Examiner</b> Carolyn Smith	<b>Art Unit</b> 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 83-86 and 88-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 83-86 and 88-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1631

### **DETAILED ACTION**

Applicant's amendments and remarks, filed 10/22/09, are acknowledged. Amended claims 83, 90, 94, cancelled claims 1-82, 87, and new claims 99-100 are acknowledged.

Applicant's arguments, filed 10/22/09, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from the previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 83-86 and 88-100 are herein under examination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 83-86 and 88-100 are rejected under 35 U.S.C. 102(e) as being anticipated by Lapointe et al. (US 6,678,669). This rejection is maintained for claims 83-86 and 88-98 and necessitated by amendment for claims 99-100.

Art Unit: 1631

Lapointe et al. disclose a method and system for identifying new markers for disease to design new tests and improve the sensitivity and specificity of tests as well as medical diagnostic tests that generate groups of individuals useful in researching disease influence in individuals (abstract; col. 1, last paragraph to col. 2, first paragraph; col. 3, last two paragraphs to col. 4, first paragraph; col. 5, last paragraph to col. 6, last paragraph; col. 20, third paragraph; claim 38) which represents a method and system for selecting one or more disease-influencing genes needed to be processed for medical research (as stated in the preambles of instant claims 83, 90) as well as identifying individuals having a disease-influencing gene (as stated in the preamble of instant claim 94). Lapointe et al. disclose collecting observation by examining and querying a group of test patients in whom the medical condition is known (claim 38; col. 6, fourth paragraph) which represents selecting individuals having a risk factor for a disease, as stated in instant claim 83. Lapointe et al. disclose the method and system are computer-based with a consensus of networks and several processors involving input interface screen and inputting patient information (claims 1, 3; col. 2, first paragraph; col. 6, fourth paragraph; col. 9, second paragraph; col. 10, lines 60-62; col. 84, second to third paragraph; Figure 11), as well as a computer connectable with a monitoring device that monitor pulse rate or blood pressure (col. 11, seventh paragraph; col. 12, seventh paragraph; col. 15, seventh paragraph) with the system adapting to the particular environment (col. 6, last paragraph) which represents providing a communications apparatus (as stated in instant claim 83, 90), a communication network (as stated in instant claims 90, 94), a communication apparatus connectable with a monitoring device (as stated in instant claim 88, 94) involving blood pressure and pulse rate (as stated in instant claims 89, 94, 96). Lapointe et al. disclose sending queries to each individual, for

Art Unit: 1631

example "Do you smoke?" supplied in a computer-readable form to a system operating on a computer (instant claims 3, 38; col. 15, seventh paragraph) and using a script program (col. 89-239; Figures 11 and 13) which represents presenting queries to each individual through an apparatus (as stated in instant claim 83, 94) and script-based queries (as stated in instant claims 84, 90, 91, 95) and a script program (as stated in instant claims 85, 91, 95). Lapointe et al. disclose answers to questions, collecting input data storing patient data and further train systems to develop systems that are adapted to a particular genetic population, inputting additional data (claim 38; col. 6, fourth and last paragraphs; col. 9, second paragraph) which represents receiving and storing responses of each individual, as stated in instant claims 83, 90. Lapointe et al. disclose categorizing observations and defining similar groups, categorizing responses from patient historical questionnaires, and categorizing women into different classes (claims 38, 52; Figure 4; col. 30, lines 45-46; col. 14, fifth paragraph; col. 15, fourth and fifth paragraphs) and categorizing individuals via identifying the disease state or condition of a patient as well as adapting systems for a particular genetic population (claim 38, col. 6, second and last paragraphs) and diabetes (col. 9, third paragraph) which represents defining a plurality of groups including phenotypic classifications. Lapointe et al. disclose before, during or after collecting observations from a group of test patients, performing biochemical tests on at least one test patient and categorizing them into a set of candidate variables and providing biochemical test results for all or a subset of patients for whom the patient data are known with biochemical tests including bioassays and collecting genetic history of a patient and using genetic algorithms (claims 60, 116; col. 22, second paragraph; col. 25, fourth paragraph) using a genetic algorithm and NeuroGenetic Optimizer and Knowledge discovery in data (KDD) which identifies

Art Unit: 1631

relationships among variables as well as identifying variables and sets thereof ranking variables and finding correlations (col. 13, last paragraph; col. 7, third paragraph to col. 8, first paragraph; col. 18, lines 17-67; col. 20, third and fifth paragraphs; col. 22, second paragraph), which represents receiving and comparing genotype information, as stated in instant claims 83, 90, 92, 94, 97. Lapointe et al. disclose developing systems for a particular genetic population, identifying subsets of relevant variables and outputting information (col. 6, fourth to sixth paragraphs; col. 8, second paragraph; col. 13, third paragraph; col. 27, third paragraph; claims 37, 38, 60, 116) including determining relationships and differences between variables (col. 17, second paragraph to col. 18, last paragraph; col. 29, second paragraph to col. 42, line 35; col. 49, fourth paragraph to col. 56, line 50; col. 83, second paragraph to col. 88, last paragraph) which represents generating a report that represents a subset of genotype information associated with each group wherein differences in said genotype information between said groups is expressed in terms of phenotypic classifications, as stated in instant claims 83, 90, 94. Lapointe et al. disclose categorizing individuals via identifying the disease state or condition of a patient as well as adapting systems for a particular genetic population (claim 38, col. 6, second and last paragraphs) and diabetes (col. 9, third paragraph) which represents categorizing individuals into groups by risk factor or disease progression including diabetes, as stated in instant claims 86, 90, 92, 93, 94, 97, 98, 99, 100.

Thus, Lapointe et al. anticipate instant claims 83-86 and 88-100.

Applicant summarizes Lapointe et al. and the instant invention. Applicant argues that Lapointe et al. do not disclose the defining and report generating limitations. This statement is

Art Unit: 1631

found unpersuasive as Lapointe et al. disclose categorizing observations and defining similar groups, categorizing responses from patient historical questionnaires, and categorizing women into different classes (claims 38, 52; Figure 4; col. 30, lines 45-46; col. 14, fifth paragraph; col. 15, fourth and fifth paragraphs) and categorizing individuals via identifying the disease state or condition of a patient as well as adapting systems for a particular genetic population (claim 38, col. 6, second and last paragraphs) and diabetes (col. 9, third paragraph) which represents defining a plurality of groups including phenotypic classifications. Lapointe et al. disclose developing systems for a particular genetic population, identifying subsets of relevant variables and outputting information (col. 6, fourth to sixth paragraphs; col. 8, second paragraph; col. 13, third paragraph; col. 27, third paragraph; claims 37, 38, 60, 116) including determining relationships and differences between variables (col. 17, second paragraph to col. 18, last paragraph; col. 29, second paragraph to col. 42, line 35; col. 49, fourth paragraph to col. 56, line 50; col. 83, second paragraph to col. 88, last paragraph) which represents generating a report that represents a subset of genotype information associated with each group wherein differences in said genotype information between said groups is expressed in terms of phenotypic classifications, as stated in instant claims 83, 90, 94. It is noted that the "generating a report" limitation is written very broadly which only requires a "subset" of information "associated" with each group. Applicant argues that claims 83, 90, and 94 now include subject matter similar to now cancelled claim 87 which was not rejected by prior art. It is noted that Lapointe et al. disclose all the limitations of instant claim 87 except for "genetic expression" which was not added to amended claims 83, 90, and 94. Applicant argues that claims dependent from instant claims 83, 90, and 94 are allowable because instant claims 83, 90, and 94 are allowable. This

Art Unit: 1631

statement is found unpersuasive as instant claims 83, 90, and 94 are not allowable for the reasons given above.

***Other prior art***

Although not being used as prior art, the following reference is being made of record: Herren et al. (US 6,108, 635) disclose a method and integrated disease information system with an interface involving querying, receiving user input of biological parameters, projecting disease progression outcomes taking risk factors into account for various groups, and analyzing for each group of patient types based on standard categories of factors.

***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1631

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The Central Fax Center number for official correspondence is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. If you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (571) 272-0721. The examiner can normally be reached Monday through Thursday from 8 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran, can be reached on (571) 272-0720.

Application/Control Number: 09/496,893

Page 9

Art Unit: 1631

February 11, 2010

/Carolyn Smith/  
Primary Examiner  
AU 1631